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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/208,195	12/09/98	SCHNITZER	J BIDMC98-20

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EXAMINER

NOLAN, P

ART UNIT

PAPER NUMBER

1644

12

DATE MAILED:

07/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/208,195

Applicant(s)

Schnitzer et al.

Examiner

Nolan

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 4/17/00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above claim(s) 10, 18, 23, 26 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-9, 11-17, 19-22, 24-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 10
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**Part III DETAILED ACTION**

1. Claims 1-26 are pending.

2. Applicant's election with traverse of Group I in Paper No. 11 is acknowledged. The traversal is on the ground(s) that said purified caveolae could not be isolated by another method. This is not found persuasive because Applicant's claims are drawn to purified caveolae, which as evidenced by U.S. Patent No. 5,776,770, can be made by another method.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 10, 18, 23 and 26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 11, 13-15 and 19-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stan et al. (AS2).

Stan et al., teaches the immunoisolation of caveolae by disrupting the plasma membrane with sonication and separating the disrupted fraction by sucrose density gradient centrifugation and subjecting the fractions to immunoisolation by polyclonal antibodies attached to magnetic beads, thereby producing purified caveolae. The polyclonal antibodies would inherently bind the oligomerized form of caveolae since they recognized the caveolae in its natural state, prior to being denatured (see figure 2).

The prior art teachings anticipate the claimed invention.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8, 9, 12, 16, 17, 21, 22, 24 and 25 are rejected under 35 U.S.C. § 103 as being unpatentable over Stan et al. (AS2).

Stan et al., has been discussed supra.

The claimed invention differs from the prior art teaching(s) by the recitations of incubating the antibody with the fraction for 1 or 2 hours or the initial membranes are disrupted by shearing. However, it is well within the purview of one of ordinary skill in the art in immunoassays to be motivated to optimize antibody incubation times to reduce assay time and furthermore, the use of shearing is a well recognized method to disrupt membranes, as evidenced by U.S. Patent No. 5,776,770 and therefore lends no patentable weight to Applicant's claimed invention.

One of ordinary skill in the art at the time the invention was made would have been motivated to optimize antibody incubation time or use shearing to disrupt the plasma membrane because both methods are well within the purview of one of ordinary skill in the art in immunoassays. From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

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7. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.  
Patent Examiner, Group 1640  
June 30, 2000